

REMARKS

I. Introduction

Claims 1-21 are pending in the above application.

Claims 19 and 20 are withdrawn.

Claims 1, 2, 5-13 and 16-18 stand rejected under 35 U.S.C. § 102(e).

Claims 3, 4, 14 and 15 stand rejected under 35 U.S.C. § 103(c).

Claim 21-23 are newly added.

Claims 1, 10, 18, 19, 20 and 23 are independent claims.

II. Amendments

Claims 1, 2, 3, 6, 7, 8, 9, 10, 13, 14 and 18 have been amended to remove language that may be construed as reciting a means-plus-function limitation. No new matter has been added.

III. Prior Art Rejections

A. Claims 1, 2, 5-13 and 16-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burke. Applicants respectfully traverse the rejections.

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349, 48 U.S.P.Q.2D (BNA) 1225 (Fed. Cir. 1998); and Connell v. Sears, Roebuck & Co., 220 USPQ 193, 198 (Fed. Cir. 1983).

Burke does not disclose an image synthesizer that generates a scale image, representing a substantially real size, at a position specified on the image presented on the display in accordance with three-dimensional positional information of the object and for combining the scale image

with the image of the object, as recited by amended claim 1. Burke discloses a technique to create a computerized model of a store layout. Abs. In modeling the store layout, Burke discloses to utilize information regarding the shelf and product size. See. Col. 4, ln. 65 through Col. 5, ln. 20; and Col. 7, lns. 26-54. Burke merely discloses generating information describing product and shelf sizes and locations in three dimensions. See, Col. 2, lns. 45-60. Burke does not disclose the above noted features of amended claim 1. Accordingly, as Burke does not disclose each and every limitation of amended claim 1, Burke does not anticipate amended claim 1, nor claims 2 and 5-9 which depend on amended claim 1 and incorporate all of the limitations thereof.

Burke also does not disclose an image synthesizer which combines respective images of multiple objects together in accordance with three-dimensional positional information of the objects so that at least one of the object images is scaled up or down according to a desired size relationship, as recited by amended claim 10. The Office action does not appear to particularly address these limitations of amended claim 10. In any event, as discussed above, Burke merely discloses generating information describing product and shelf sizes and locations in three dimensions, and does not disclose these features of amended claim 10. Accordingly, as Burke does not disclose each and every limitation of amended claim 10, Burke does not anticipate amended claim 10, nor claims 12-13 and 16-17 which depend on amended claim 10 and incorporate all of the limitations thereof.

Furthermore, Burke does not disclose an image synthesizer which generates an image, representing the object substantially in its real size when presented on the display, by scaling the image up or down in accordance with three-dimensional positional information of the object, as recited by amended claim 18. Burke merely discloses generating the picture in which the

products would appear organized on a shelf in an actual store. See. Col. 5, lns 37-38. Burke does not disclose the above recited feature of amended claim 18. Accordingly, as Burke does not disclose each and every limitation of amended claim 18, Burke does not anticipate amended claim 18.

B. Claims 3, 4, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burke in view of Parghi et al. (U.S. Pat. 6,396,495).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the *claimed invention* where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Ecolochem Inc. v. Southern California Edison Co., 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). See also MPEP 2143.01.

Claims 3 and 4 depend from independent claim 1 and incorporate all of the limitations thereof. Claims 14 and 15 depend from independent claim 10 and incorporate all of the limitations thereof.

Neither Burke nor Parghi, taken alone or in combination, disclose all of the claimed elements of claims 3 and 4, which incorporate the limitations of amended claim 1, nor all of the claimed elements of claims 14 and 15, which incorporate the limitations of amended claim 10. Burke does not disclose all of the claimed elements of independent claims 1 or 10 as discussed above. Parghi does not make up for the deficiencies of Burke. Parghi discloses a technique to

generate a real light source and a virtual light source in a manner to appear as if they are originating from a common light source. Abs. Parghi discusses determining dimensions "using theodolite or similar accurate measuring equipment." See, Col. 4, lns. 45-52. However, Parghi does not disclose an image synthesizer that generates a scale image, representing a substantially real size, at a position specified on the image presented on the display in accordance with three-dimensional positional information of the object and for combining the scale image with the image of the object, as recited by amended claim 1, and the Office action does not rely on Parghi as disclosing such. Parghi also does not disclose an image synthesizer which combines respective images of multiple objects together in accordance with three-dimensional positional information of the objects so that at least one of the object images is scaled up or down according to a desired size relationship, as recited by amended claim 10, and the Office action does not rely on Parghi as disclosing such.

Accordingly, as neither Burke nor Parghi, taken alone or in combination, disclose all of the claimed elements, neither Burke nor Parghi, taken alone or in combination produce the claimed inventions recited in amended claims 1 or 10. Hence, neither Burke nor Parghi, taken alone or in combination, render claims 3 and 4, which depend on amended claim 1, nor claims 14 and 15, which depend on amended claim 10 unpatentable.

IV. New Claim 21-23

New claim 21-23 is believed to be patentable over the prior art because none of the prior art is believed to disclose or suggest the combination of elements which constitute the invention recited therein. New claims 21 and 22 depend on claims 1 and 10, respectively, and are also patentable at least for the same reasons as claims 1 and 10, respectively.


V. Conclusion

Applicant respectfully submits that the application is in condition for allowance, an early indication thereof is respectfully solicited. Should the Examiner have any questions or concerns regarding the amendments presented herein, the Examiner is invited to contact the undersigned representative of the Applicant.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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